

REMARKS/ARGUMENTS

Claims 1-5, 7, 13-30 and 33-83 are canceled. Claims 84-89 are added. Claims 6 and 8-12 are amended. Claims 6, 8-12, 31 and 32 are pending. No new matter is added, and no new issues are raised. Entry of the amendments is requested. Applicants respectfully request reconsideration of the rejections.

New claims 84-89 are directed to adenovirus vectors comprising the enhancer sequences set forth in Claims 9-12. The claims are dependent on Claim 31, and raise no new issues for patentability. Claim 6 has been amended to refer to the sequence set forth in Claim 8 (nucleotides about 8021 to about 8371 of SEQ ID NO:1), and as such raises no new issues. Claim 8 has been amended for purposes of clarity to indicate that the enhancer activity is prostate specific.

The presently pending claims have been rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over the following:

Claims 1-21 and 24-31	U.S. Patent no. 6,676,935
Claims 1-17	U.S. Patent no. 6,432,700
Claims 1-8 and 11-15	U.S. Patent no. 6,495,130
Claims 1-20 and 22-26	U.S. Patent no. 6,436,394
Claims 1-26 and 28-54	U.S. Patent no. 6,197,293
Claims 1-22	U.S. Patent no. 6,585,968
Claims 1-20 and 22-26	U.S. Patent 6,436,394
Claims 1-11	U.S. Patent no. 6,051,417

Without acceding to the correctness of the rejection, in order to further prosecution Applicants have provided terminal disclaimers of the present claims, for the above listed patents. Withdrawal of the rejection is requested.

A provisional rejection has been made of claims 1-14, 31 and 32 over claims 1-28 of US Application 20030152553, or claims 1-9, 19, 22, 26-39, 41, 49-55, 59-63, 67 and 68 of US Application 20030118555, or claims 1-12, 14, 18-28, 41-43 and 47-58 of US Application 20030068307. -

Applicants respectfully submit that in a provisional double patenting rejection it is proper to issue the present application, thereby converting the provisional rejection.

Claims 1-6 have been rejected under 35 U.S.C. 112, first paragraph as lacking written description; and Claims 1-4 and 6 under 35 U.S.C. 112, first paragraph as not enabled. Without

conceding to the correctness of the rejection, Claims 1-5 have been canceled, without prejudice to refilling or renewal of the original scope. Claim 6 has been amended to refer to an isolated polynucleotide comprising nucleotides 8021-8371 of SEQ ID NO:1. Applicants respectfully submit the present claims meet the requirements of 35 U.S.C. 112.

The Office Action states that "with regard to Claim 6, neither the specification nor the prior art provides guidance as to what modifications to bases 8021-8371 are permissible, and which modifications will inactivate the enhancer contained with this sequence."

Applicants respectfully submit that one of skill in the art is well-informed as to modifications that can be made to the core enhancer sequence. For example, nucleotides 8021-8371 of SEQ ID NO:1 include the androgen responsive element (shown in Figure 11). It shown that this sequence is required for enhancer activity. In addition, androgen responsive elements and methods for assessing the binding of the androgen receptor to such elements were known in the art (for example, see Zhang et al. (1997) N.A.R. 25:3143-3150). Suitable nucleotide substitutions are readily determined by one of skill in the art, utilizing the sequences provided by Applicants and the methods set forth in the specification.

Applicants respectfully submit that the present claims meet the requirements of 35 U.S.C. 112. Withdrawal of the rejection is requested.

CONCLUSION

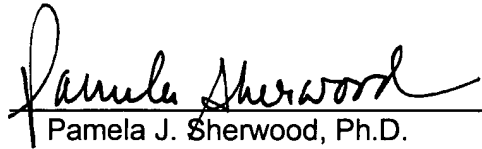
Applicants submit that all of the claims are now in condition for allowance, which action is requested. If the Examiner finds that a Telephone Conference would expedite the prosecution of this application, he is invited to telephone the undersigned at the number provided.

USSN: 09/875,228

The Commissioner is hereby authorized to charge any other fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-0815, order number CELL-011CON.

Respectfully submitted,

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